IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re Patent Application of:

Wendell W. ANTHONY

Serial No.:	**09/077,456**	Art Unit:	**3684**
Filed:	**May 29, 1998**	Examiner:	**Susanna M. MEINECKE DIAZ**

For: **IMPROVED METHOD AND SYSTEM FOR PERFORMING BANKING TRANSACTIONS, INCLUDING HOME BANKING**

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Included below is a concise summary of arguments for which this review is requested. A Notice of Appeal accompanies this request. The undersigned representative respectfully requests a Pre-Appeal Brief Request for Review of the rejections of record in view of the following remarks.

Claims 1, 6-9, 11-14, 18, 20-30, 33-36, 38-43, 47, and 49-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,220,501 to Lawlor et al. ("Lawlor") in view of U.S. Patent No. 5,485,370 to Moss ("Moss") and further in view of U.S. Patent No. 5,705,798 to Tarbox ("Tarbox"). Claims 4, 10, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and Tarbox and further in view of Official Notice. Claims 15-17, 19, 44-46, and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and Tarbox and further in view of Munroe, Tony. "Citibank Offers Service Link Through Computers at Home." Washington Times, Washington D.C., Section B, page 7, November 10, 1994 ("Munroe"). Claims 1, 30, and 57 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Rejection of Claims 1, 6-9, 11-14, 18, 20-30, 33-36, 38-43, 47, and 49-58 under 35 U.S.C. § 103(a) Is Improper

Lawlor, Moss, and Tarbox, alone or in combination, fail to teach each and every element of the pending claims for at least the following reasons.

A. Every Element Must Be Considered, including Installation by a Customer.

Neither Lawlor, Moss, nor Tarbox teaches "providing user software for installation by a customer of the business host on the at least one home banking terminal," as recited in independent claim 1, " user software for installation by a customer of the business host on the at least one home banking terminal," as recited in claim 30, and "user software installed by a customer of the business host," as recited in independent claim 33. The Examiner has not identified any reference that teaches this feature.

These claim limitations clearly require that ***the customer install the user software*** on the home banking terminal. As a result, a method or system having the user software would differ based upon whether the software is installed by the customer or the business host on the customer's home banking terminal. Yet, on page 5 of the Office Action, the Examiner asserts that "the claims do not specify how the method is affected by the nature of the person doing the installation itself," a conclusion which has no basis in the laws, regulations, or precedential cases. But it is well founded that "all words of a claim be considered." MPEP 2143.03. The courts have held that when determining whether a claim is obvious, an examiner must make "a searching of the claimed invention - including ***all its limitations*** - with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). The Examiner cannot read this limitation out of the claims, thereby rendering the limitation as meaningless. *See Cat Tech LLC v. Tubemaster, Inc.*, 528 F.3d 871, 885 (Fed. Cir. 2008) (claim limitation should not be construed to render it "functionally meaningless."). So the burden remains on the Examiner to provide a teaching of each and every claim limitation, including installation by the customer.

When properly considering each and every element of the claim, the combination of Lawlor with Moss do not teach user software for installation by a customer of the business host on the home banking terminal. Lawlor recites that no hardware or installation expense is required for the devices. Col. 8, lines 6-19; col. 20, lines 7-10. Moss recites, *e.g.*, col. 18, lines 6-17, that packet assembly and disassembly (PAD) is placed in the home terminal so that application programs are retained in the host computer, not the home terminal. Thus, "application programs

do not have to be downloaded to the home terminal." Col. 18, lines 13-15. So the programs described in Moss are not installed on the home terminal by anyone because the application programs are not downloaded or installed to the home terminal. Accordingly, the combination of Lawlor with Moss do not teach user software for installation by a customer.

Tarbox fails to cure this deficiency because Tarbox stores preferences on a transaction card, and that card transmits the preferences when the card is used at an ATM. Col. 5, lines 10-53. Tarbox merely teaches a way to customize already installed applications on the ATM. Thus, the cited references fail to teach installation by a customer on the home banking terminal.

B. <u>A Personal Computer Is Not an ATM.</u>

Lawlor, Moss, and Tarbox fail to teach "the home banking terminal is a personal computer," as recited in claim 1. The Examiner's assertion that an ATM is equivalent to a personal computer (PC) fails for at least two reasons: (1) a ATM and a PC have different functionality as even recited by Lawlor, and (2) a customer cannot install software on an ATM, as discussed above. On pages 6-7 of the Office Action, the Examiner asserts that "The ATM functions as a personal computer and is, thus, effectively a type of personal computer within the scope of Lawlor." An ATM and a PC operate differently. As generally understood in the art, an ATM is a machine that has a limited number of functions, which are generally tailored toward banking transactions. Meanwhile, a PC is a general purpose computer that offers nearly unlimited functionality because a user can choose and install new software on the PC to give the PC more functionality.

Lawlor even highlights the differences between an ATM and a PC. Lawlor recognized the advent of PCs, col. 1, lines 20-25, but believes that the PCs cannot satisfy the intended purpose of home banking. Col. 2, lines 2-29. Lawlor further highlights the disadvantages in having banks install special purpose software on PCs. Col. 2, lines 29-35. As a result, Lawlor concludes that "***PC-based home banking is not yet a practical reality*** for most consumers. In fact, many home banking programs launched in the past have been declared ***failures and discontinued***." Col. 2, lines 45-50 (emphasis added). Instead, Lawlor uses an ATM, which is recognized as allowing user to "access only a limited number of bank teller services." Col. 4, lines 12-14. Thus, Lawlor teaches away from the use of a PC and certainly from any consideration that an ATM and a PC are equivalent.

Moss's home terminal is not a PC either. Moss teaches the home terminal is extremely simple so that those who are not computer savvy can use and understand it. Col. 3, lines 60-65. Moss's home terminal is a telephone with a microcomputer. Col. 4, lines 10-15. The telephone has limited input commands, and like an ATM, a limited number of functions. Tarbox describes an ATM, and for the reasons set forth above, cannot teach a PC. Thus, none of the references teach "providing user software for installation by a customer of the business host on the at least one home banking terminal."

On page 4 of the Office Action, the Examiner now asserts that the structural limitations should not be considered because "the type of terminal used does not affect the manipulative steps of the method." Once again, the Examiner is reading limitations out of the claim, and it is evident that an ATM cannot function as a substitute for home banking where the claim requires a personal computer. The cited references merely discuss ATMs or limited functionality terminals, but none of the references teach the use of a personal computer that can be configured as a home banking terminal. One of ordinary skill in the art, or any customer with a bank account, would recognize the functional difference between the use of a personal computer for home banking versus an ATM or a telephone. The Examiner is not entitled to read a limitation out of the claims once it is established that the *prima facie* case of obviousness has not been met with the cited references.

C. <u>The User Configures the Communication Method for their Home.</u>

The cited references fail to teach "installed user software on the remote terminal enables the remote terminal to allow multiple users of the remote terminal to each select from different languages when accessing the remote terminal and enables configuration by the user of the remote terminal for a communication method available at a home of a user," as recited in claim 6. The cited references recite that the terminal follows certain rules, not that a user configures the communication method for remote terminal at their home. Lawlor recites that the terminal dials an appropriate internally-stored telephone number. Col. 26, lines 10-11. Moss recites that the home terminal has a packet assembler and disassembler that follows formatting rules provided by a service provider. Col. 4, lines 47-53. Tarbox stores preferences on a transaction card, and that card transmits the preferences when the card is used at an ATM. Col. 5, lines 10-53. None of the cited references teach that the installed user software enables configuration by the user of the remote terminal for a communication method available at a home of a user.

The Rejection of Claims 4, 10, and 37 under 35 U.S.C. § 103(a) Is Improper

Claims 4, 10, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and Tarbox and further in view of Official Notice. The cited references fail to teach "allowing multiple users of the plurality of remote terminals to configure the user software to reflect each user's preferences, wherein the preferences include a language and to configure a communication method of the user's terminal with a standard international host in accordance with communication methods available at the user's home," as recited in claim 4. As discussed above with respect to claim 6, the combination of Lawlor with Moss and Tarbox would not have suggested configuration by the user of the remote terminal for a communication method available at a home of a user. Applicant's alleged admitted prior art, as applied to claim 4, does not remedy these shortfalls of Lawlor, Moss, and Tarbox.

The Rejection of Claims 15-17, 19, 44-46, and 48 under 35 U.S.C. § 103(a) Is Improper

Claims 15-17, 19, 44-46, and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and Tarbox and further in view of Munroe. For at least the reasons discussed above, the cited references do not teach each and every element of claims 1, 6, 30, and 33, and Munroe fails to cure the deficiencies. Because the independent claims are believed to be allowable, the claims depending therefrom are also believed to be in condition for allowance.

The Rejection of Claims 1, 30, and 57 under 35 U.S.C. § 112 Is Improper

Claims 1, 30, and 57 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because there is no antecedent basis for "the installed user software." In claim 1, and similarly in claims 30 and 57, this term is preceded by a step of "providing user software for installation," so it necessarily follows that the "installed user software" is the user software provided for installation. Thus, the limitation "the installed user software" has a proper antecedent basis.

CONCLUSION

In view of the remarks stated above, the undersigned representative respectfully requests that the rejections of claims 1, 4, 6-30 and 33-58 be withdrawn and a notice of allowance is earnestly solicited.

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Respectfully submitted,

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